

III. Remarks

A. Response to Rejection of Claims 46, 57–58, 61, 63, 64 and 66–70 Under 35 U.S.C. § 103

Claims 46, 57–58, 61, 63, 64 and 66–70 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined disclosures of United States Patent No. 5,750,563 to Honda, in view of United States Patent No. 5,322,689 to Hughes et al.

1. Subject matter of Applicant's claimed invention

Applicant's claim 46 is directed to an antimicrobial composition consisting essentially of a mixture free of benzyl alcohol and containing from 0.1 to 90% by weight of a polyphenol selected from the group consisting of tannins and tannic acid and 0.1 to 30% by weight of lactic acid, the mixture containing no other generally recognized as safe flavored alcohols. Applicant's specification at page 6, lines 10–17 and page 7, lines 6–19 discloses a number of hydrophilic GRAS flavor alcohols such as ethanol, propanol and isopropanol and lipophilic GRAS flavor alcohols, including lower alcohols such as n-butyl alcohol and isobutyl alcohol, and higher alcohols such as laurel alcohol and 1-hexadecanol.

2. Comparison between the subject matter of Applicant's claimed invention and the disclosures of Honda and Hughes et al.

Honda discloses a preparation for epidermis comprising kojic acid, ultraviolet light absorbents and 0.001 to 20% by weight alcohols. Honda discloses that the alcohols to be used are lower alcohols such as ethanol, propanol and isopropanol, and higher alcohols such as hexadecanol and laurel alcohol (column 3, lines 12–17 and 48–51).

Accordingly, Applicant's claimed antimicrobial composition excludes alcohols that come within the general definition and specific listing of alcohols which are disclosed in Honda as an essential ingredient. All of Applicant's remaining claims are also directed to compositions consisting essentially of a mixture containing none of the generally recognized as safe flavored alcohols other than the defined polyphenol selected from the group consisting of tannins and tannic acid.

In the rejection, the Examiner has relied on Honda for a preparation comprising polyphenols, antimicrobial agents and carrier materials and the suggestion of the inclusion of

humectants. The Examiner has then relied on Hughes et al. for the disclosure that lactic acid is a humectant.

Hughes et al. is directed to a topical oil and water emulsion composition useful for releasing an aromatic decongestant composition comprising a carboxylic copolymer and volatile aromatic compounds (column 2, lines 26–54). Hughes et al. describes as optional components pharmaceutical actives such as benzyl alcohol (which is excluded from Applicant's claimed antimicrobial composition), as well as humectants/moisturizers. (See column 6, line 12 to column 9, 61 and column 9, lines 41–47). In Hughes et al., lactic acid is identified as one of a number of humectants and moisturizers and is not disclosed as a preferred humectant/moisturizer for use in the compositions of the Hughes et al. invention. (See column 7, lines 39–59). Hughes et al. does not exemplify, disclose or even suggest to one of ordinary skill in the art the exclusion from the Hughes et al. composition of benzyl alcohol and other generally recognized as safe flavored alcohols, other than polyphenol.

**3. There exists no *prima facie* case of obviousness
of claims 46, 57, 58, 61, 63, 64 and 66–70
over the combined disclosures of Honda and Hughes et al.**

Under Section 2143 of the Manual of Patent Examining Procedure:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The combination of Honda and Hughes et al. does not teach or suggest all the claim limitations. For example, Honda and Hughes et al. do not teach or suggest to one of ordinary skill in the art, Applicant's claimed composition consisting essentially of a mixture containing no other generally recognized as safe flavored alcohols other than polyphenol. Indeed, the Honda composition comprises alcohols that are identified as generally recognized as safe flavored alcohols in Applicant's specification. The modification of Honda to remove the essential alcohol

component would render the Honda composition unsatisfactory for its intended purpose. As set forth in Section 2143.01 of the Manual of Patent Examining Procedure:

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733, F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

In addition, the disclosure in Honda that a humectant can be added as an optional ingredient does not support the position that the disclosure in Hughes et al. can be used to modify the Honda composition to obtain Applicant's claimed composition plus the excluded GRAS flavored alcohol. As noted in the Action at page 3, lines 4–6, Honda also discloses as another carrier, extracts such as camphor. Hughes et al. discloses camphor under the list of useful anesthetic or antipruritic drugs that also includes benzyl alcohol (column 9, lines 41–48). Accordingly, the motivation to include lactic acid in the Honda composition would similarly apply to including benzyl alcohol in the Honda composition. As Applicant's claimed antimicrobial composition consists essentially of a mixture free of benzyl alcohol, the claimed exclusion of benzyl alcohol is another claim limitation not taught or suggested by the combination of Honda and Hughes et al.

Accordingly, for the reasons set forth above, the rejection of claims 46, 57–58, 61, 63, 64 and 66–70 under 35 U.S.C. § 103(a) as being unpatentable over the combined disclosures of United States Patent No. 5,750,563 to Honda, in view of United States 5,322,689 to Hughes et al. is untenable and should be withdrawn.

B. Response to Rejection of claim 65 under 35 U.S.C. § 103

Claim 65 is rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined disclosures of Honda, in view of United States Patent No. 5,416,075 to Carson et al. Carson et al. is relied on as disclosing antimicrobial emulsions comprising extracts and antimicrobial compounds. The extracts are identified as including essential oils, including camphor, orange oil and anise oil. Carson et al. does not disclose Applicant's claimed antimicrobial composition consisting essentially of a mixture free of benzyl alcohol, containing from 0.1 to 90% by weight of a polyphenol selected from the group consisting of tannins and tannic acid, 0.1 to 30% by weight of lactic acid, and that the mixture contains no other generally recognized as safe flavored alcohols. Accordingly, Carson et al. provides no motivation to one of ordinary skill in the art to

Response
to Final Office Action of October 23, 2006

PATENT
Serial No. 09/743,883; Filing Date March 26, 2001
Examiner Micah-Paul Young; Art Unit 1618
Attorney Docket No. 501-06/VK011

modify the Honda composition to obtain Applicant's composition. Hence, a rejection of claim 65 under 35 U.S.C. § 103(a) as being unpatentable over the combined disclosures of United States Patent No. 5,750,563 to Honda, in view of United States Patent No. 5,416,075 to Carson et al. is untenable and should be withdrawn.

Response
to Final Office Action of October 23, 2006

PATENT
Serial No. 09/743,883; Filing Date March 26, 2001
Examiner Micah-Paul Young; Art Unit 1618
Attorney Docket No. 501-06/VK011

IV. Conclusion

It is believed that the above Amendment and Remarks constitute a complete Response under 37 C.F.R. § 1.111 and that all grounds for objection stated in the Action have been adequately rebutted or overcome. A Notice of Allowance in the next Action is therefore requested. The Examiner is requested to telephone the undersigned counsel if any matter that can be expected to be resolved in a telephone interview is believed to impede the allowance of the pending claims of Application Serial No. 09/743,883.

Respectfully submitted,

PAUL AND PAUL

Date: April 23, 2007

/John S. Child, Jr./

John S. Child, Jr.
Registration No. 28,833
2000 Market Street
Suite 2900
Philadelphia, PA 19103-3229
Telephone: (215) 568-4900
Facsimile: (215) 568-5057

CORRESPONDENCE ADDRESS:

Customer No. 27569
John S. Child, Jr., Esquire
Paul and Paul
2000 Market Street, Suite 2900
Philadelphia, PA 19103-3229

Order No. 4818